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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,514	04/20/2006	Herbert Wolter	060953-0138	3740

22428 7590 02/24/2010
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WASHINGTON, DC 20007

EXAMINER

PRICE, ELVIS O

ART UNIT	PAPER NUMBER
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1621

MAIL DATE	DELIVERY MODE
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02/24/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/576,514	WOLTER, HERBERT	
	Examiner	Art Unit	
	ELVIS O. PRICE	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 37-44 is/are pending in the application.
- 4a) Of the above claim(s) 37-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 40-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-14 and 37-44 are pending in the application, claims 15-36 having been canceled.
2. New claim 44 has been added by the amendment filed 11/18/09 and claims 37-39 remain withdrawn from consideration.
3. Applicant's amendment, filed 11/18/09, has overcome the claim objections and 35 USC 112, second paragraph rejections issued in the Office Action dated 8/18/09.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, 8, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolter et al. {US Pat. 6,124,491}.

Wolter et al. disclose Silane compounds as defined by the present structure (1a) (see the methacrylate silane compounds in Examples 1, 3, 6 and 7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 6, 7, 9, 11, 13, 14 and 40-44 rejected under 35 U.S.C. 103(a) as being unpatentable over Wolter et al. {US Pat. 6,124,491}.

Wolter et al. teach Silane compounds as presently claimed (see Silane compounds represented by formula (I) and Col. 2 through 21). The difference between the presently claimed silane compounds and what is taught by Wolter et al. is that Wolter et al. do not exemplify the specific silane compounds as recited in the present claims 6, 9, 11, 13, 14 and 40-44.

It would have been *prima facie* obvious to one having ordinary skill in the art, in view of Wolter et al., to arrive at the presently claimed silane compounds because Wolter et al. teach a range of silane compounds, represented by formula (I), which encompass the presently claimed silane compounds. One having ordinary skill in the art, desiring to arrive at other art recognizable silanes which can be hydrolyzed and/or polymerize to form polycondensates and polymerizates, would have been motivated to use any silane compound within the scope of the silane compounds taught by Wolter et al. Therefore, the presently claimed invention would have been obvious to one having ordinary skill in the art.

Response to Arguments

Applicant's arguments filed 11/18/09 have been fully considered but they are not persuasive.

Applicant argues that the compound disclosed by Wolter et al. in Example 1 is not a compound of the present structure (Ia) because there is no moiety that corresponds to the present variable B in the compound of Example 1 if the present variable Z' is regarded as one of the left most carboxyl groups in the compound of Example 1.

This argument is not convincing because the definitions because the Examiner regards the two left most carboxyl groups as corresponding to the Z' variable which would mean that the B variable would correspond to the allyl moiety $\text{CH}_2=\text{C}(\text{CH}_3)-$. Hence, the compound disclosed by Wolter et al. reads on the presently claimed compound as defined by the present structure (Ia).

Applicant argues that that if the Z' variable is regarded as a $-\text{CO}(\text{O})-$ group then the variable B' would correspond to the said allyl moiety above and B' must be a methacrylate group that contains a C=C bond.

This argument is not persuasive because the B' variable corresponds to the ally moiety, of the compound in Example 1 of Wolter et al., which ally moiety is in fact part of a methacrylate residue.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 1621

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELVIS O. PRICE whose telephone number is (571)272-0644. The examiner can normally be reached on 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel M. Sullivan can be reached on 571 272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elvis O. Price/
Primary Examiner, Art Unit 1621